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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,657	11/10/2003	Jeremy Thaler	10770013010202	6140
37211	7590	08/22/2008	EXAMINER	
BASCH & NICKERSON LLP 1777 PENFIELD ROAD PENFIELD, NY 14526				PRATT, HELEN F
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
08/22/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/705,657	THALER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Helen F. Pratt	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 July 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-20 and 22-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

**The finality of the last office action has been withdrawn in favor of the action found below.**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 10, 12-18, 20, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (6,982,101) in view of Hinds et al. (UNHYDROGENATED PALM OIL as a Stabilizer for Peanut Butter) and Harris et al. (2,560,509) and further in view of Bailey's Industrial Oil and Fat Products, pages 168-170.

Liu discloses a peanut butter spread as in claims 1, 12 and 15 having ground peanuts added in amounts from 60-80% and oil in the amounts of 1-15%. The

reference discloses the use of "at least one stabilizer in a total amount up to about 4wt %. "Up to" reads on zero.

Liu discloses a sweetened nut butter spread made by grinding nuts in the presence of oil at a temperature of from ambient to 165 F (abstract and col. 2, lines 50-70). Cooling is a given since peanut butter is not kept in a heated state. The palm oil is used in amounts from 1-15%, preferably 2-12% (col. 3, lines 5-10, 20-25). A nut paste is disclosed which contains at least 9-% peanuts (col. 2, lines 1-70). Claims 1, 12, 15 differ from the reference in the use of organically grown peanuts and organic palm oil. Nothing new is seen in using organically grown peanuts as opposed to commercially grown peanuts, absent a showing of unexpected results in using peanuts which are grown without the use of chemical fertilizers. Claim 12 further requires that no free oil on the surface and storage for 60 days. However, as the composition has been shown, it is seen that no oil is on the surface and the storage is as claimed. Therefore, it would have been obvious to use known organically grown peanuts and to make a product that has no free oil on the surface of the peanut butter for 60 days.

Claims 1, 12 and 15 have been amended to require that the oil is palm stearin oil. However, Liu et al. disclose the use of palm oil and Hinds et al. disclose that it is known to use an unhydrogenated palm oil as a stabilizer for peanut butter (abstract), and that the fatty acid composition of palm oil is 4.-5.5% stearic (page 816, col. 1, 3<sup>rd</sup>, para.). Harris et al. disclose that it is known to make peanut butter with sugar and polyglycerols melted at from 55-80 C (col. 1, lines 44-55, col. 2, lines 1-1-34). The polyglycerol can be of the stearic acid monoester of a polyglycerol variety. The reference discloses that

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higher molecular weight fatty acids can be used in small amounts in nut butters (col. 3, lines 22-48). As it is disclosed that the stearic acid is helpful in keeping oil from separating, it would have been within the skill of the ordinary worker to choose natural oils containing stearic acid, with little routine experimentation, to find a natural oil, which contains stearic acid. Harris et al. also, discloses the use of monostearin and distearin (col. 1, lines 25-30. In addition, as shown by applicants' specification, on page 4, 3<sup>rd</sup> paragraph, Organic palm Stearin (POS) is a known ingredient and "that other alternative organic palm oil products made by Spectrum and other suppliers may be substituted as equivalents". Applicants can use palm oil and the specification does not limit the claims to palm oil stearin. No criticality has been shown in the use of palm oil stearin. Also, Bailey's disclose the use of POS which have functional properties, such as a narrow melting range, and a pleasant mouthfeel and has a shown interval between setting and melting point and can crystallize with increasing stability (page 169, , page 170, 3<sup>rd</sup>, para.). Therefore, it would have been obvious to use unhydrogenated palm oil which contains stearic acid since as a higher long chain fatty acid, it is more solid at room temperatures than other oils.

Nothing new is seen in adding the oil during the grinding step into the mill, as in claim 13 as this has to have been done in order for the peanuts to have been ground (abstract). Liu discloses grinding nuts in the presence of oil to make a nut paste (col. 1, lines 50-55). However, Harris discloses that it is known to combine a high stearin ingredient with nut butter at from 50-80 C (col. 1, lines 44-55, col. 2, lines 1-3, col. 3, lines 25-41). Nothing has been shown as to the product being any difference if the

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stearin oil is adding only in the mixing phase as in claim 12. If it were added during grinding, it would still be in the mixture in the combining phase. Therefore, it would have been obvious to dispense oil into the apparatus during grinding of the nuts or in the combining step as shown by the reference as no criticality is seen in either method.

Claims 14 and 15 further require preheating the oil before dispensing the oil into the mill at particular temperatures and claim 16 requires roasting the peanuts before grinding. The reference is silent as to heating the oil. However, nothing new is seen in heating the oil before adding it since the peanut paste and oil were maintained at a temperature above 133 F. absent a showing of unexpected results using the claimed temperatures. Certainly the nuts are roasted before grinding (col. 2, lines 41-50). Therefore, it would have been obvious to dispense oil into a mill at particular temperatures and to grind the nuts prior to roasting.

Liu discloses roasting nuts at from 270 to 370 as in claim 17 (col. 2, lines 41-50). Therefore, it would have been obvious to roast at known temperatures.

Removing the skins is disclosed in col. 2, lines 44-50 as in claim 18.

Nothing new is seen as in claim 20 of collecting and pumping the peanut mixture to a heat exchanger and filling station, which is routinely done in the art. Therefore, it would have been obvious to collect, and pump the mixture in order to put it into containers.

Adding salt and sweetener is disclosed in col. 5, lines 40-60, as in claims 22 and 23, and milling to within the claimed range is disclosed in Lui who uses from 10-20 mils, preferably 13 mils.

Claims 1, 3-8, 10, 12-18, 20, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinds and further in view of Baileys Industrial Oil and Fat Products.

Hinds et al. disclose as in claim 1 that it is known to make a composition containing ground peanuts stabilized with palm oil. In addition, as shown by applicants' specification, on page 4, 3<sup>rd</sup> paragraph, Organic palm Stearin is a known ingredient and "that other alternative organic palm oil products made by Spectrum and other suppliers may be substituted as equivalents". Applicants can use palm oil and the specification does not limit the claims to palm oil stearin. The use of only "palm stearin oil is not seen as critical. In addition, as shown by applicants' specification, on page 4, 3<sup>rd</sup> paragraph, Organic palm Stearin (POS) is a known ingredient and "that other alternative organic palm oil products made by Spectrum and other suppliers may be substituted as equivalents". No criticality has been shown in the use of palm oil stearin." Also, Bailey's disclose the use of POS which have functional properties, such as a narrow melting range, and a pleasant mouthfeel and has a shown interval between setting and melting point and can crystallize with increasing stability (page 169, and page 170, 3<sup>rd</sup>, para.). Mixtures of palm oil in amounts of 2-4% and ground peanuts were tested, so it is seen that 90% ground peanuts were used (page 817, col. 1, para. 1-3). The amount of fat in the peanut butter (PB) would have been less than 55% since the peanuts contain only 49%, (page 1, col. 1, para. 4, line 5). Claim 1 differs from the reference in the use of organically grown peanuts and in the amount of oil, and in whether there would be free oil on the surface of the peanut butter. However, no difference is seen in the use of organically grown peanuts and those grown with fertilizers at this time.

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Whether the peanuts are grown with organic fertilizers or chemicals, chemicals are also found in organic fertilizers as everything is made up of chemicals or chemical compounds. The reference discloses that in using amounts of 2-4% oil, no free oil is seen on the surface of the PB up to 29 C. (page 815, page 1, para. 1, under Results and Discussion and col. 2, top graph). The claim requires from “about 5% oil” since it is not known what the range of ‘about 5%’ encompasses. Also, no patentable distinction is seen at this time between the use of 4% oil and 5% oil. Also, as it is well known that the amount of oil in a peanut butter product affects its taste, it would have been obvious to add a little more oil for its known function. Therefore, it would have been obvious to use more oil in a PB composition for its known function.

The melting point of palm oil is disclosed to be 36-40 C. as in claim 3 (page 816, col. 1, 2<sup>nd</sup> para. of Hinds et al.). No patentable distinction is seen in 4 degrees, as the melting point is influenced by the amount of saturated fat, which might vary from product to product. Also, Applicants’ particular POS has been disclosed as a known product in the specification. Therefore, it would have been obvious to substitute the POS of a known product for the PO of Hinds for its more precisely fractionated stearin portion.

Claim 4 further requires heating the palm oil before it is blended with the peanuts. However, this is a method limitation in a composition claim. Nothing is seen that the palm oil is not at the melting point since it is referred to as an oil. Therefore, it would have been obvious to use the palm oil in the form of an oil as disclosed by the reference.

Claims 5 and 6 require particular amounts of salt and sweetener from zero amounts up. The reference used 4.71% sugar and .79% salt (page 817, col. 2, para. 1.).

Claim 7 further requires unrefined organic cane sugar, and claim 8 requires particular types of well-known sweeteners. No patentable distinction is seen in the use of well-known sweeteners or in the use of organic sweeteners. Of course, aspartame, saccharine and cyclamate, are not organic sweeteners as they are man made.

Claim 8 further requires the use of the germ of the peanut. Nothing is seen that the germ has been removed from the peanut as in Hinds et al. It is well known that the germ can be used or not used.

Claim 10 further requires Valencia peanuts and claim 11 a particular particle size. The reference uses Florunner seed (page 817, last. Para. ). It would have been within the skill of the ordinary worker to use particular types of peanuts, since the varieties used are well known as are their characteristics. The reference discloses that the mixture was finely ground (0.13 mm clearance between stones) (page 817, 1<sup>st</sup> para.). It is not seen that this is different than that claimed at this time. Nothing is seen that oil would have been seen on the surface of the peanut butter after 60 days. Therefore, it would have been obvious to use known peanuts and to grind to a particular degree absent unexpected results.

Claim 12 is to the method of grinding the peanuts in a mill and claim 13 that the oil is dispensed into the throat of the mill. The further limitations have been disclosed above and are obvious for those reasons. Hinds et al. disclose grinding peanuts in a

vertical mill and adding the other ingredients (page 817, para. 1.). Nothing new is seen in adding oil at the most convenient place in the apparatus. Therefore, it would have been obvious to grind as disclosed.

Claims 14 and 15 further require preheating the oil before dispensing the oil into the mill at particular temperatures and claim 16 requires roasting the peanuts before grinding. The reference is silent as to heating the oil. However, nothing new is seen in heating the oil before adding it since the peanut paste and oil were maintained at a temperature above 133 F. absent a showing of unexpected results using the claimed temperatures. Certainly the nuts are roasted before grinding (col. 2, lines 41-50). Therefore, it would have been obvious to dispense oil into a mill at particular temperatures and to grind the nuts prior to roasting.

Roasting peanuts is well known as in claim 17, and it would have been obvious to roast at known temperatures to achieve a desired flavor.

The peanuts are blanched as in claim 18 (page 817, para. 1).

Nothing new is seen as in claim 20 of collecting and pumping the peanut mixture to a heat exchanger and filling station, which is routinely done in the art. Therefore, it would have been obvious to collect, and pump the mixture in order to put it into containers.

Adding salt and sweetener is disclosed as above as in claims 22 and 23.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hinds et al. as applied to the above claims, and further in view of Liu et al. (6,982,101).

Claim 24 further requires milling the peanuts to from 10 to 15 microns. Liu discloses milling to within the claimed range uses from 10-20 mils, preferably 13 mils. (col. 2, lines 51-60 and col. 5, lines 1-15). Nothing new is seen in a particular size particle of peanuts absent a showing of unobvious results, since it is known to grind peanuts to various particle sizes. Therefore, it would have been obvious to mill peanuts as disclosed by Liu et al. in the process of Hinds et al.

Claims 9, 11,19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinds et al. (UNHYDROGENATED PALM OIL as a Stabilizer for Peanut Butter) and Harris et al. (2,560,509) as applied to claims 1, 10, 12-18, 20, 22-23, and further in view of Krisinski et al. (4,143,176).

Krisinski et al. disclose that it is known to use particle sizes of from 8-20 microns as in claims 11 and 24 (col. 1, lines 58-70). Also, Krisinski et al. disclose that it was known to make a conventional peanut butter using normal skins and germ in the amounts of 50-60% as in claims 9 and 19 (col. 2, lines 22-41). Therefore, it would have been obvious to grind to a particle size as claimed as shown by Krisinski et al. in the process of the combined references and to add the germ to the composition.

Claims 9, 11,19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinds et al. (UNHYDROGENATED PALM OIL as a Stabilizer for Peanut Butter) and Harris et al. (2,560,509) as applied to claims 1, 3-8, 10, 12-18, 20, 22-23, and further in view of Krisinski et al. (4,143,176).

Krisinski et al. disclose that it is known to use particle sizes of from 8-20 microns as in claims 11 and 24 (col. 1, lines 58-70). Also, Krisinski et al. disclose that it was

known to make a conventional peanut butter using normal skins and germ in the amounts of 50-60% as in claims 9 and 19 (col. 2, lines 22-41). Therefore, it would have been obvious to grind to a particle size as claimed as shown by Krisinski et al. in the process of the combined references and to add the germ to the composition.

## ARGUMENTS

Applicant's arguments filed 6-18-08 have been fully considered but they are not persuasive.

Applicants argue that Liu teaches away from the present invention as it is to nut butter spreads and that peanut oil is the preferred edible oil, and that a sweetening composition is used which contains a stabilizer to prevent oil separation which can be hydrogenated vegetable oil. However, the claims are open comprising type claims, and no ingredients have been excluded from the claims.

Applicants argue as to the use of "at least one stabilizer in a total amount up to about 4 wt.%", that it does not teach "no stabilizer". However, the patent and the claims have different embodiments of the invention. In the specification there are at least two embodiments, one without a stabilizer and one with, and the same as in the claims (col. 1, lines 45-70, col. 2, lines 1-25). In the patented claims, claims 10-14 do not require a stabilizer, nor do claims 50-52. The term preferably does not mean that a stabilizer is required. Nothing has been shown that the composition of Liu would

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separate without the use of a stabilizer, especially with the use of palm oil which Liu states would prevent oil separation (abstract).

Applicant argues that Liu does not teach particular amounts of the non-hydrogenated organic palm stearin oil. However, the reference discloses from 2-15% oil, which can be palm oil, which is known to contain stearin (col. 3, lines 5-10, lines 20-25). It would have been within the skill of the ordinary worker to use particular amounts of oil to make a suitable composition as only a limited amount of testing is required to determine what amount makes the most stable product. Certainly, the problem of oil on the surface of peanut butter is notoriously old, hence any ground peanut butter with no additives, and the inventors in the Liu patent would have been aware of this problem and would have adjusted their ingredients accordingly. Routine experimentation can be used as in the KSR decision, in it being obvious to try, i. e. choosing from a finite number of identified, predictable solutions. In this case, only so much of the POS or palm oil would be necessary to stabilize peanut butter. Also, the result is predictable, as POS is known to stabilize as disclosed by Lui et al. in view of Baileys (KSR, 119 Fed Appx 282, 288 (Fed.Cir.2005)).

Applicants argue that there is no basis for combining the references. However, Lui et al. disclose the use of palm oil in peanut butter spread, Hinds et al. specifically discloses the use of palm oil in peanut butter, applicants' specification, shows no criticality in the use of POS, and actually says that palm oil is used in the composition, Harris et al. discloses monostearin and distearin and stearic acid as above, Baileys'

discloses that the claimed POS is known for its crystallizing stability, which is what a fat would have to do in order to prevent oil separation in peanut butter.

Applicants argue that the limitation of combining ingredients with ground peanuts in a mill with oil has not been shown. Liu discloses grinding nuts in the presence of oil to make a nut paste (col. 1, lines 50-55). However, Harris et al. disclose that it is known to combine a high stearin ingredient with nut butter at from 50-80 C (col. 1, lines 44-55, col. 2, lines 1-3, col. 3, lines 25-41). Nothing has been shown as to the product being any different if the stearin oil is added only in the mixing phase. If it were added during grinding, it would still be in the mixture in the combining phase.

Adding more oil for its known function, means adding more oil for its lubricating effect or its effect of helping set up the product during solidification according to the amount of stearin in the oil or higher weight fatty acids.

Applicants argue it is conclusionary to say that adding oil or heating it is known. It is not seem as conclusionary when it is well known in the art to do such. Certainly, one would heat an oil which becomes solid at low temperatures, so that it would mix easily, and the outcome of such heating is known, i. e. easy mixing.

Applicants argue that the claimed amount of oil has not been shown. However, given that the outcome of adding more oil can be predicted, i. e. its function of stabilizing the peanut butter, so no excess oil would have been apparent, it would have been obvious to add enough oil given that Hinds disclose adding oil to peanuts to prevent oil separation (abstract).

Applicants argue as to Krisinki that only 50-60% portion of the germ is indicated as desirable. However, this is an ingredient which is within the skill of the ordinary worker to add. Nothing new or unobvious has been shown in adding more of the germ, which itself is a tiny particle to the mixture.

Applicants argue as to homogenization in regard to claims 9 and 11. However, they are composition claims and homogenization is not required. It is not seen how loosing flavor volatiles has anything to do with peanut germ as argued.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Helen F. Pratt/

Primary Examiner, Art Unit 1794

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